

QMET 201 US (10104949)REMARKS

In light of the above amendment and remarks to follow, reconsideration and allowance of this application are requested.

Claim 23 has been cancelled. Accordingly, claims 1-6, 8-10, 12-15, 17-22, 25-27, and 29-45 are presented for consideration.

Claims 1-6, 8-10, 12-15, 17-23, 25-27, and 29-45 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over an article by Ware et al. entitled "The Search for More Practical and More Precise Outcomes Measures," The Quality of Life Newsletter, January-April 1999 (Ware) and in view of U.S. Patent No. 6,067,523 to Bair et al. (Bair). Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. However, the claimed combination cannot change the principle of the operation of the reference or render the reference inoperable for its intended purpose. (MPEP § 2143.01 citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Applicants respectfully submit that only the present invention teaches or suggests generating a customized test based on a patient's characteristics and selected health domain, and dynamically modifying the generated customized test if an estimated confidence level is outside a threshold. Whereas Ware describes a process of selecting a question from a database and stopping the selection process once preset standard of

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precision is met. Contrary to the Examiner's assertion, Ware does not describe generating a customized test based on patient's characteristics and selected health domain, and dynamically modifying the generated customized test if an estimated confidence level is outside a threshold, as required in independent claims 1, 18, 35, and 39, or any of dependent claims 2-6, 8-10, 12-15, 17, 19-22, 25-27, 29-38, 40-45.

Additionally, the Examiner admits that Ware et al. does not describe the health domains being selected by a patient or a health care provider as required by the pending claims. To cure this deficiency, the Examiner turns to Bair. However, Bair does not teach or suggest generating a customized test based on patient's characteristics and selected health domain, and dynamically modifying the generated customized test if an estimated confidence level is outside a threshold. Bair merely describes generating a test from a master question table and skipping certain related questions based on the answer to the first related question. For example, if the patient answers that she has no history drug abuse, then the drug related questions (i.e., what drugs are you taking) will be skipped. Hence, Bair does not teach or suggest dynamically modifying the test based on the confidence level threshold. Therefore, the addition of Bair does not cure the aforementioned deficiency of Ware. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness because Ware and Bair independently or in combination therewith do not describe all the claim limitations of the pending claims.

Moreover, the claimed invention defined by independent claims 1, 18 35 and 39 eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention attempts to mimic the evaluation process performed by a professional health care provider. Typically, the health care professional administrating the test may inquire deeper into certain issues raised by the patient's answer. The present invention attempts to provide such flexibility in administrating the test. It is undeniable that Ware or Bair individually or in combination therewith is not even remotely concerned with providing such flexibility. Since applicants have recognized a problem not addressed by the cited prior art and solved that problem in a

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manner not suggested by cited prior art, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem was recognized and solved by providing such flexibility of mimicking the health care professional's evaluation process during the administration of the test on the fly, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is... entitled to patent protection". Id. at 121.

In view of the foregoing, withdrawal of the final rejection and allowance of this application are respectfully requested.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of applicant's undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

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Applicants believe no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **QMET 201 (10104949)** from which the undersigned is authorized to draw.

Respectfully submitted,



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